

REMARKS

Claims 1-7 are all the claims pending in the application.

Minor editorial amendments have been made to Claim 5.

No new matter has been added.

I. Rejection Under 35 U.S.C. § 112

Referring to Section No. 2 at page 2 of the Office Action, Claims 5 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicants respectfully traverse.

As an initial matter, Applicants have the following comments with respect to the scope of dependent Claims 5 and 6 (and Claim 3) and independent Claim 1, from which each of Claims 5 and 6 depends.

Claim 1 is directed to a pressure-sensitive adhesive (PSA) tape or sheet comprising a substrate having a PSA layer on at least one side thereof. Claim 1 recites, *inter alia*, that a surface portion of the PSA layer within the range of up to 3 nm inward from an outer face of the PSA layer contains (B) an anionic emulsifier containing a sulfur atom in a proportion of from 0.1 to 3 parts by weight based on 100 parts by weight of the whole of the monomer components constituting an acrylic polymer (A).

Claim 5 depends from Claim 1 and recites that the PSA layer on one side of the substrate has a multilayered structure. Claim 5 also recites that an outermost layer of the multilayered PSA layer has a thickness of from 1 to 5 μm and contains the anionic emulsifier (B) in a proportion of from 0.1 to 3 parts by weight based on 100 parts by weight of the whole of the monomer components constituting the acrylic polymer (A).

In comparison to the range of 0.1 to 3 parts by weight in the outermost layer of the multilayered structure, Claim 5 recites that the multilayered PSA layer as a whole contains the

anionic emulsifier (B) in a proportion of from 0.5 to 5 parts by weight based on 100 parts by weight of the whole of the monomer components constituting the acrylic polymer (A).

Claim 6 also depends from Claim 1 and recites that the PSA layer as a whole contains the anionic emulsifier (B) in a proportion of from 3 to 5 parts by weight based on 100 parts by weight of the whole of the monomer components constituting the acrylic polymer (A).

Thus, in comparison to Claim 1, wherein the amount of anionic emulsifier (B) in the PSA layer as a whole is not particularly limited, so long as the amount of (B) in the surface portion of the PSA layer within the range of up to 3 nm inward from an outer face of the PSA layer is within the range of 0.1 to 3 parts by weight, Claim 6 recites that the amount of (B) in the PSA layer as a whole ranges from 3 to 5 parts by weight, while also reciting that the amount of (B) in the surface portion of the PSA layer ranges from 0.1 to 3 parts by weight.

Contrary to the assertion at page 2 of the Office Action, Claim 6 does not require the PSA layer to have a multilayered structure. Furthermore, the scope of Claim 6 is virtually identical to the scope of Claim 3, except that Claim 3 recites that the amount of (B) in the PSA layer as a whole ranges from 0.5 to 5 parts by weight, while also reciting that the amount of (B) in the surface portion of the PSA layer ranges from 0.1 to 3 parts by weight (by virtue of its dependence from Claim 1).

In view of the comments above with respect to the scope of dependent Claims 5 and 6 (and Claim 3) and independent Claim 1, Applicants respectfully traverse the §112 rejection of Claim 5 for the following reasons.

Like the words of a statute, each word in a claim should be given its own meaning if possible.¹ In Claim 5, the meaning of “the pressure-sensitive adhesive layer on one side of the substrate has a multilayered structure” is clear. Regardless of whether the anionic emulsifier (B) is present in identical amounts in an outermost layer of the multilayered PSA layer and in the multilayered PSA layer as a whole, Claim 5 still recites that the PSA layer has a multilayered

¹ Winter v. Fujita, 53 USPQ2d 1234, 1244 (Bd. Pat. App. & Int. 1999).

structure. The statement at page 2 of the Office Action that “[b]y so doing, of course, no layered structure is required to exist for these embodiments ...” completely ignores the recitation in Claim 5 that “the pressure-sensitive adhesive layer on one side of the substrate has a multilayered structure.”

With respect to Claim 6, unlike Claim 5, Claim 6 does not recite that the PSA layer has a multilayered structure. Claim 6 is directed to specific embodiments of Claim 1 wherein the PSA layer as a whole contains the anionic emulsifier (B) in a proportion of from 3 to 5 parts by weight based on 100 parts by weight of the whole of the monomer components constituting the acrylic polymer (A).

Claim 1 contains no particular recitation concerning the amount of (B) in the PSA layer as a whole.

For the foregoing reasons, Applicants request reconsideration and withdrawal of the §112 rejection.

II. Rejection Under 35 U.S.C. § 103

Referring to Section No. 4 at pages 3 and 4 of the Office Action, Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,103,316 (“US ‘316”).

Applicants respectfully traverse.

Focusing on independent Claim 1, it recites, *inter alia*, that a surface portion of the PSA layer within the range of up to 3 nm inward from an outer face of the PSA layer contains (B) an anionic emulsifier containing a sulfur atom in a proportion of from 0.1 to 3 parts by weight based on 100 parts by weight of the whole of the monomer components constituting an acrylic polymer (A).

US ‘316 does not disclose (either expressly or inherently) the above element of Claim 1. Furthermore, US ‘316 does not contain a teaching or suggestion that would lead one of ordinary skill in the art to modify its disclosure and arrive at the subject matter of Claim 1, in the manner required by 35 U.S.C. § 103.

US '316 does not *expressly* state (at column 36 and Table 12, including the PSA articles of Examples 44-46, or elsewhere) the proportion of S DS-10 or TL-100 (corresponding to claimed component (B)) in the surface portion of the PSA layer within the range of up to 3 nm inward from an outer face of the PSA layer. US '316 makes no distinction at all between the composition of the surface portion of its PSA layers and the composition of the PSA layers as a whole.

US '316 also fails to *inherently* disclose an amount of a component corresponding to claimed component (B) present in a surface portion of the PSA layer, i.e., in a portion of the PSA layer within the range of up to 3 nm inward from an outer face of the PSA layer, falling within the claimed range of 0.1 to 3 parts by weight based on 100 parts by weight of the whole of the monomer components constituting the acrylic polymer (A) that forms the surface portion of the pressure-sensitive adhesive layer.

As evidence, Applicants are submitting herewith the Rule 132 Declaration of co-inventor Yutaka Tosaki. Mr. Tosaki conducted an experiment to show that US '316 does not inherently disclose the above element of Claim 1.

In particular, for the reasons stated in the Declaration, Mr. Tosaki identified Example 46 of Examples 44-46 of US '316 as being closest to the pressure-sensitive adhesive tape or sheet of Claim 1. By the methodology described in the Declaration, Mr. Tosaki reproduced Example 46 of US '316 and discovered that, in a surface portion of the PSA layer within the range of up to 3 nm inward from the outer face of the PSA layer:

- (i) a component corresponding to claimed anionic emulsifier (B) is contained in a proportion of 59.4 parts by weight per 100 parts by weight of the entire monomer component, thus falling outside the range recited in Claim 1; and
- (ii) a ratio of sulfur element was 1.9 atomic% determined by ESCA measurement, thus falling outside the range recited in Claim 4.

Because US '316 does not contain a teaching or suggestion that would lead one of ordinary skill in the art to modify the amount of its component corresponding to claimed anionic

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emulsifier (B) contained in a surface portion of the PSA layer within the range of up to 3 nm inward from the outer face of the PSA layer, US '316 fails to render obvious the subject matter of Claim 1 in the manner required by 35 U.S.C. § 103.

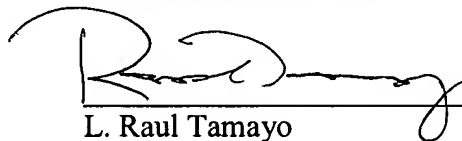
Applicants request reconsideration and withdrawal of the §103 rejection of Claims 1-7.

III. Conclusion

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. Raul Tamayo', written over a horizontal line.

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